SEP 18 2008
PATENT & TRADEMARK OFFICE

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Daisuke UESUGI et al.

Group Art Unit: 4111

Application No.: 10/524,844

Examiner: R. GRUN

Filed: February 17, 2005

Docket No.: 122799

For: CRYSTALLIZATION METHOD OF NECK OF PRIMARY MOLDED PRODUCT FOR BIAXIALLY-ORIENTED BLOW-MOLDED BOTTLE-SHAPED CONTAINER AND JIG TO BE USED FOR THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 18, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1-5 and 8-13, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

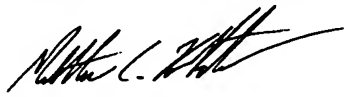
A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.* Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims. *See* ISPE 10.06.

The Office Action implicitly acknowledges that *a priori* unity of invention exists because independent claims 1 and 6 relate to "thermally crystallizing a neck of a primary molded product for forming a bottle-shaped container made of polyethylene terephthalate." See page 2. However, the common technical feature is not merely "thermally treated threading on a PET bottle" as asserted by the Office Action. *Id.*

Rather, the corresponding technical features of a general inventive concept that define a contribution over the prior art at least include "squeezing the bead ring heated to the heat-deformable temperature, from outside so as to form an outer diameter of the bead ring within a dimensional tolerance for deformation" as required by claim 1, which may be accomplished by a jig having a "cylinder [that] has a reduced diameter section and a tapered section outwardly expanded at a lower end thereof" as required by claim 7. JP 2002-145238 to Atsushi ("Atsushi") fails to teach or suggest such technical features. Accordingly, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* lack of unity of invention.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Matthew C. Barthalow
Registration No. 60,323

JAO:MCB/jls

Date: September 18, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461